

REMARKS

Claims 1-30 stand rejected as obvious in view of respective combinations of a number of references.¹ In particular, claims 1, 7-13, 14, 18, and 22-23 are rejected under §103(a) as obvious over “Document Object Model Level 1 Specification,” W3C (1998)(hereinafter “W3C”) in view of *Awareness Through Fisheye Views in Relaxed-WYSIWIS Groupware*, (1996)(hereinafter “*GroupLab*”). Claims 6, 15-17, 19-21, 24-26, and 28-29 have been rejected as obvious over W3C, further in view of *GroupLab*, further in view of *Edupage Newsletter* (February 4, 1997)(hereinafter “*Edupage*”). Claims 27 and 30 have been rejected as obvious over W3C, further in view of *GroupLab*, further in view of *Edupage*, and further in view of “*HTML Tags at a Glance*” (hereinafter “*HTML Tags*”). Claims 4 and 5 have been rejected as obvious over W3C, further in view of *GroupLab*, further in view of *W3C’s Scalable Vector Graphics Specification* (February 11, 1999)(hereinafter “*SVG*”).

Claims 1, and 4-7

It is noted that each rejection, including that of claim 1, is made under §103 and not §102. As such, the Applicants and the Office appear to be in agreement that the invention is not itself described in the prior art. It is only through the selective combination of diverse prior art teachings that the Office has purported to find the invention in the prior art. Since almost every new invention is made up of a combination of old elements, the temptation of hindsight is certainly strong, and in fact it is certainly difficult to place one’s self in the historical mindset of the artisan at the time the application was filed. For this reason, the law imposes strict and clear requirements governing the Office’s combining of references as was done in the subject Office action.

The MPEP has described these requirements for the convenience of Office personnel and practitioners and that description will be briefly reviewed herein. In particular, the MPEP sets forth three basic criteria that must be met before references can be combined in an obviousness rejection. MPEP §2143. First and foremost among these requirements is the mandate that there must be a suggestion or motivation originating in the art (not from the Examiner, not from the application) to modify or combine the references in the asserted manner. Secondly, there must be a reasonable expectation of success, again found in the art, with respect to the asserted combination, and thirdly the references as combined/modified must teach each and every element of the targeted claim.

Applicants respectfully assert that in the present case none of these requirements have been adhered to. Addressing the first requirement first, there is no motivation in the art to make the asserted combinations. For example, with respect to claim 1 (and claims 7-13, 14, 18, and 22-23), alleged to be obvious in view of a combination of W3C and GroupLab, there is no reason found in the art to make the asserted combination. The reason that the Office has given to attempt to justify the combination is that “it would have been obvious ... to combine W3C’s DOM [document object model] with GroupLab’s thumbnail registration with a document since mapping coordinates to a data structure and thumbnails provide a means to link to another document.”

However, this is simply a statement that one of skill in the art *could* combine the known art to arrive at the invention. It is a statement of ability or possibility, not a statement of motivation. As stated in the MPEP, the mere fact or assertion that one of skill in the art could have made the asserted combination has no bearing on motivation, i.e. the question of whether one of skill in the art would have made the asserted combination. MPEP §2143.01 (p. 2100-126)(“ The mere fact that references can be combined or modified does not render the

¹ Note that claims 2-3 were previously cancelled.

resultant combination obvious unless the prior art also suggests the desirability of the combination.”)

In the present case, the Office seems to be asserting that all the pieces of the invention were out there and that one of skill in the art would have been able to combine them to make the invention. However, this is exactly the type of “motivation” that the MPEP condemns as being insufficient. *Id.* Moreover, considering that the Office action, at the top of page 3, seems to be saying that GroupLab’s fisheye view used something analogous to thumbnails to provide a function similar to that of the invention, it is especially difficult to then try to understand what the motivation for *modifying* that system would have been. Is the Office asserting that the Fisheye technology was somehow deficient or left something to be desired from the perspective of one of skill in the art at that time? If not, then is there some other reason why the Fisheye technique would have appeared to one of skill in the art to need modification so as to align more closely with applicants’ later claims? Does the Office’s assertion that the combination is desirable “since mapping coordinates to a data structure and thumbnails provide a means to link to another document” imply that there was no linking in the GroupLab’s fisheye technique? This would seem to contradict the Office’s other characterizations of GroupLab.

In short, the question that both Federal Law and the MPEP require an answer to is not “could the artisan have made the combination?” —rather, the question is “why would the artisan have made the combination?” A purported answer to the former question has been given, but by law that answer has no bearing on patentability and does not support a prima facie case of obviousness. Clarification is respectfully requested as to the answer to the latter question.²

² Although these are subsidiary points, Applicants also briefly note that the corresponding reasonable expectation of success is not identified in the art for any of the claims, nor are all of the claim elements for each claim truly

With respect to dependent claims 4-7, it is respectfully submitted that these claims are patentable for at least the reasons stated above with respect to parent claim 1. Moreover, each dependent claim recites additional limitations that render the claim patentable. More significantly, the required motivation to make the asserted combinations is lacking.

For example, to justify combining SVG with W3C and GroupLab to reject claims 4 and 5, the action states that “Since XML is a structured document, **it would have made sense** to one of ordinary skill in the art at the time the invention was made to incorporate images and vector graphics in a system for registering a thumbnail with a document **since the technology for including images and vector graphics in structured documents already existed.**” (emphasis added). The action itself thus clearly demonstrates that the Office is citing not an actual motivation to combine, but simply an ability to combine – it “would have made sense” (i.e. the artisan could have done it) since the “technology” (i.e. the ability) existed.

As another example, with respect to claim 6, the action justifies combining a third reference (Edupage) with two others (W3C and GroupLab) by simply stating: “It would have been obvious ...to incorporate the applet [for word at a time display] with the system described jointly by W3C and GroupLab since the system represents a document model consisting of text and other components registered with a thumbnail.” Not only does this rationale bootstrap off the combination of W3C and GroupLab, which is itself an improper combination, but in addition the cited motivation to add Edupage is lacking in and of itself. It essentially says that since the applet works with text and the combination of W3C and GroupLab works with text, the former can be combined with the latter. But an allegation that

art can be combined has no bearing on whether the artisan would have made the combination, for that requires not just evidence of ability, but also evidence of motivation.

Because claims 1 and 4-7 are patentable over the art of record for the reasons discussed above, Applicants respectfully request that claims 1 and 4-7 be favorably reconsidered and rejections thereof withdrawn.

Claims 8-13

As with independent claim 1, the rejection of independent claim 8 was made under § 103. It is respectfully submitted that, in addition to issues regarding the second and third requirements for a prima facie case of obviousness, the first requirement, i.e. a motivation in the art to make the asserted combination, has not been met. Claim 8 is rejected under a combination of W3C and GroupLab. In an attempt to motivate the asserted combination, the action states that “since DOM represents the hierarchy of XML data that are linked to a portion of a document from a document model (as taught by W3C) and it was well known ... to provide reduced images (thumbnails) from which a user could select coordinates linking to the larger document, it would have been obvious... to combine W3C’s DOM hierarchy with GroupLab’s thumbnail registration with a document since mapping coordinates to a data structure and thumbnails provide a means to link to another document. Both thumbnails and DOM provide users with the ability to communicate with another document.”

As with the alleged motivation asserted with respect to claim 1, the “motivation” asserted with respect to claim 8 actually states at best only ability and not motivation. The request for clarification stated above is repeated with respect to claim 8. That is, assuming for the sake of argument that the action is right in that the artisan *could* make the asserted combination, why *would* the artisan do so? If “both thumbnails and DOM provide users with the ability to communicate with another document,” as alleged, and if GroupLab shows

something “analogous to a thumbnail,” as alleged, then why *would* the artisan modify either GroupLab or W3C in the asserted manner? Clarification is respectfully requested.

With respect to dependent claims 9-13, it is respectfully submitted that these claims are patentable for at least the reasons stated above with respect to independent claim 8. Moreover, each dependent claim recites additional limitations that render the claim patentable.

Accordingly, it is respectfully requested that claims 8-13 be favorably reconsidered, and that the rejections thereof be withdrawn.

Claims 14-21

Addressing independent claim 14 and 18 first in this group, these claims stand rejected on identical grounds, claim 18 being similar to claim 14, but being in a Beauregard format. As with independent claims 1 and 8, independent claims 14 and 18 stand rejected under a combination of W3C and GroupLab. The alleged motivation for making the combination is the same as that stated for claims 1 and 8. In view of this, Applicants respectfully restate their traversal of the stated motivation and request clarification as outlined above.

With respect to dependent claims 15-17 and 19-21 it is respectfully submitted that these claims are patentable for at least the reasons stated above with respect to independent claims 14 and 18. Moreover, each dependent claim recites additional limitations that render the claim patentable. Moreover, where these claims are rejected based on additional knowledge not found in the two base references, the combination appears to be improper. For example, the alleged motivation stated with respect to Edupage in the rejection of claim 15 is deficient for the reasons stated above with respect to claim 6. (The rejection of claim 19 is respectfully traversed for the same reason).

Accordingly, it is respectfully requested that claims 14-21 be favorably reconsidered, and that the rejections thereof be withdrawn.

Claims 22-23

Claim 22 stands rejected under a combination of W3C and GroupLab in the same manner as independent claim 8. For the reasons stated above in the discussion of claim 8, the rejection of claim 22 is respectfully traversed and clarification as to the required motivation to combine is respectfully requested. With respect to dependent claim 23, it is respectfully submitted that this claim is patentable for at least the reasons stated above with respect to independent claim 22. Moreover, claim 23 recites additional limitations that further distinguish over the cited art. Accordingly, it is respectfully requested that claims 22-23 be favorably reconsidered, and that the rejections thereof be withdrawn.

Claims 24-30

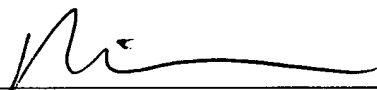
Claim 24 stands rejected under the same rationale used in rejecting independent claims 8 and 14 (namely a combination of W3C and GroupLab) further in view of Edupage. Applicants respectfully restate their traversal to the stated combination of W3C and GroupLab, and the related purported motivation, as stated above and request clarification also as outlined above. With respect to dependent claims 25-30 it is respectfully submitted that these claims are patentable for at least the reasons stated above with respect to independent claim 24. Moreover, each dependent claim recites additional limitations that render the claim patentable.

Accordingly, it is respectfully requested that claims 24-30 be favorably reconsidered, and that the rejections thereof be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If a further telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at her convenience.

Respectfully submitted,



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